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REMARKS

In response to the Office Action dated February 27, 2004, the time for responding having been extended by petition, Applicant amended claims 12, 14, 16, 18-24 and 26. Applicant cancelled claim 11. Applicant added claims 44-46. No new matter has been added.

The Examiner objected to the priority claim. Applicant amended the priority claim as suggested by the Examiner. The Examiner objected to the drawings as not depicting the subject matter claimed in claims 14 and 16. Applicant amended claims 14 and 16 as described below, and submit that the drawing objection is mooted.

The Examiner rejected claims 14 and 16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description. Applicant amended claims 14 and 16 to replace "rack" with "crossbeam". Such amendment is supported by at least Figures 1 and 2 and the text that describes those figures. The Examiner rejected claims 25 and 26-43 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant amended claims 23 and 26 to provide proper antecedent basis to the claimed terms. Applicant submits that the rejections are overcome, and requests the Examiner to withdraw the rejections.

Prior to addressing the double patenting rejection, Applicant takes this opportunity to explain the amendments to the claims. Claim 11 has been cancelled. Claim 21 has been amended to include limitations similar (but not of the same scope) to those found in claims 11 and 20. Claim 12 has been amended to depend from claim 21 as has claim 18. Therefore, claim 21 remains as the independent claim from which all claims ultimately depend, and the Examiner should review this claim in particular to determine whether an obviousness-type double patenting rejection is warranted.

The Examiner rejected claims 11-13, 15 and 17-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,331,159. Applicants traverse the rejection.

Obviousness-type double patenting requires rejection of an application claim when the *claimed* subject matter is not patentably distinct from the *claims* of the patent in question. See MPEP §804 II.B.1 (page 800-22 (8th ed. rev. 1)). In this case, the claimed subject matter of the application is patentably distinct from the claims of the parent '159 patent. Claims 1-4 of the parent '159 patent reads as follows:

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1. Apparatus for performing surgery on a heart of a patient, comprising:
  - a first arm, a second arm and an actuator, the actuator moving the first arm relative to the second arm, at least one of the first and second arms having a receptacle thereon;
  - a first blade on the first arm and a second blade on the second arm, the first and second blades having first and second surfaces facing away from each other, the first and second surfaces being adapted to atraumatically engage tissue or bone for the retraction thereof;
  - a stabilizer adapted to be coupled to one of the first and second arms and having a foot, the foot being configured to atraumatically engage the surface of the heart; and
  - a suture stay removably mounted to the receptacle.
2. The apparatus of claim 1 wherein the first and second arms are metal.
3. The apparatus of claim 2 wherein the suture stay is plastic.
4. The apparatus of claim 1 wherein suture stay is contained in a sterile package separate from the first and second arms and the first and second blades.

Note that claims 1-4 of the parent '159 patent does not describe a suture stay having at least one slot. As described above, Applicant submits that claim 21 is the appropriate claim to analyze under this rejection. Claim 21 is presented below.

21. A retractor, comprising at least one arm having a cavity, a first blade attached to the arm for retracting tissue, and a suture stay removably disposed within the cavity, the suture stay having at least one slot.

Claim 21 and any of the claims that depend from claim 21 do not include the "stabilizer" claimed in claim 1 of the '159 patent. Further as described above, claim 21 includes the limitation that the suture stay "has at least one slot". Such a limitation is not claimed in claims 1-4 of the '159 patent. Applicant submits that claims 21 of the pending application and the claims that depend therefrom, are patentably distinct from claims 1-4 of parent '159 patent as the claims of the parent '159 patent do not render claims 21-43 obvious to one of ordinary skill in the art.

The Examiner cited in re Goodman, 29 USPQ2d 2010, 2015 (CAFC 1993) for support that a generic invention is anticipated by a species. Goodman was a case involving a claim for a DNA construct, where the court found that the claims at issue generically

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described a composition, the species of which had already been claimed in a related patent. Here, claims 1-4 of the parent '159 patent are not generic to the claims of the pending application. Claims 1-4 claim a different scope than that of the pending application; not a simply a broader scope. Applicant submits that claim 21 and those that depend on claim 21 define patentably distinct subject matter from that claimed in the parent '159 patent, and respectfully requests that the Examiner withdraw the obviousness-type double patenting rejection.

The Examiner rejected claims 11-13, 15, 17-21 and 23-25 under 35 U.S.C. § 102(e) as being anticipated by Glines (U.S. Patent No. 6,190,311). Applicant traverses the rejection. Applicant has cancelled claim 11 and amended claim 21 to make it an independent claim from which all other claims depend. Applicant submits that claim 21 and its dependent claims are patentable over Glines.

Glines does not teach or suggest a retractor that includes "at least one arm having a cavity, a first blade attached to the arm for retracting tissue, and a suture stay removably disposed within the cavity, the suture stay having at least one slot". In contrast, Glitch describes a retractor 10 having arms 16 and 18, and an instrument platform 50 that snaps into openings 47 and 49 of arms 16 and 18. See Glines, Figure 1, col 3:38-43 and col 4:14-18. Instrument platform 50 includes a plurality of suture grips 58 formed in the surface of shell body 52. Glines, col 4, lines 53-65. Thus, suture grips 58 are not taught as being disposed within the openings 47 or 49. As a result, Applicant submits that Glines does not anticipate claim 21 or any of the claims that depend from claim 21, and request that the Examiner withdraw the rejection.

The Examiner rejected claims 11-20 under 35 U.S.C. § 102(e) as being anticipated by Cartier (U.S. Patent No. 6,102,854). Applicant traverses the rejection. As described above Applicant cancelled claim 11 and amended claim 21 to make it an independent claim, from which all other claims depend. Applicant submits that claim 21 and its dependent claims are patentable over Cartier.

Cartier does not teach or suggest a retractor that includes "at least one arm having a cavity, a first blade attached to the arm for retracting tissue, and a suture stay removably disposed within the cavity, the suture stay having at least one slot". In contrast, Cartier describes a retractor 1 having arms 3 and 4 and anchoring means located in discrete positions along the arms. Figures 10A-10F depict the anchoring means. Each of the anchoring means, save the

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means depicted in Figure 10F is formed in one of the arms 3, 4. The means of Figure 10F is described as: "FIG. 10F illustrates a pin type anchoring means. As illustrated the pin is advantageously slidably arranged." Cartier, col 8:37-38. Cartier does not teach that the pin of Figure 10F is *removably disposed within the cavity* of an arm. Cartier simply states that the pin of Figure 10F is slidably arranged. Further, the pin of Figure 10F does not include *at least one slot*. As a result, Applicant submits that Cartier does not anticipate claim 21 or any of the claims that depend from claim 21, and request that the Examiner withdraw the rejection.

Applicants hereby grant permission to charge any additional, necessary fees during the course of the prosecution of this application to Applicant's deposit account no. 10-0750/HRT-0278/BST.

If the Examiner believes that a discussion of the pending claims would expedite the prosecution of this application, he is invited to contact the undersigned.

Respectfully submitted,

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By: BSR  
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